



CCPY OF PAPER
ORIGINALLY FILED

#7

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Lonnie O. Ingram *et al.*

Serial No.: 09/620,060

Filed: July 21, 2000

For: RECOMBINANT CELLS THAT HIGHLY
EXPRESS CHROMOSOMALLY-INTEGRATED
HETEROLOGUS GENES

Attorney Docket No.: BCI-0092CCPCN2

Group Art Unit: 1636

Examiner: A. Chakrabarti

Commissioner for Patents
Washington, D.C. 20231

RECEIVED
FEB 19 2002
TECH CENTER 1600/2900

Certificate of First Class Mailing (37 CFR 1.8(a))

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on the date set forth below.

January 19, 2002

Date of Signature and of Mail Deposit .

By:

Peter C. Lauro, Esq.

Reg. No. 32,360

Attorney for Applicants

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is a response to the Office Action (Paper No. 5) mailed from the United States Patent and Trademark Office on July 19, 2001. A separate request for a five-month extension of time and the requisite fee based on small entity status are being filed concurrently herewith.

The Office Action, on page 2, requires restriction to one of the following groups under 35 U.S.C. §121:

Group I: Claims 1-16, 24, 33-39, 41, 46, 48 and 49, drawn to recombinant host cells, classified in class 435, subclass 252.3.

Group II: Claims 17-23, 25-32, 40, 42-45 and 47, drawn to methods of transforming cells, classified in class 435, subclass 400.

Applicants are required to elect one of the above groups for prosecution on the merits. Applicants respectfully traverse the restriction requirement and submit that the requirement is improper.

First, Applicants assert that the subject matter of these groups represent different embodiments of a single inventive concept for which a single patent should issue. The pending claims represent an intricate web of knowledge, continuity of effort, and consequences of a single invention, which merit examination of all of the claims in a single application. More particularly, all the claims are linked by a single, searchable, unifying aspect; *i.e.*, a recombinant host cell strain having certain genetic elements integrated therein by homologous recombination. Furthermore, the two groups of claims are very closely related in that the claims of Group I recite recombinant host cell strains *in "product by process" format* and the claims of Group II are directed to the process recited in the Group I claims. Applicants further point out that the requirements of the first paragraph of 35 U.S.C. §112 mandate that the method of making the claimed invention be disclosed in the application. Therefore, it is only fair that Applicants be allowed to prosecute the composition of matter claims and the method claims for making the composition of matter in a single application.

Second, Applicants submit that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. As the M.P.E.P. states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (7th ed., Rel. 78A, March 1999).

That is, even if the above-enumerated groups of claims are drawn to distinct inventions, the Examiner must still examine the entire application on the merits because doing so will not result in a serious burden.

Applicants submit that the search and examination of all the claims will have substantial overlap, and no serious burden will result from searching and examining all claims in the same application. This is especially true inasmuch as Groups I and II share the same classification, *i.e.*, class 435. Thus, the statement in the Office Action in item 3 on page 2, to the effect that the "groups have acquired a separate status in the art as shown by their different classification, is contradicted by the simple fact that the groups share the same classification. Moreover, any burden in searching and examining all the claims would not be serious given the powerful computer-based search engines and data bases at the Examiner's disposal.

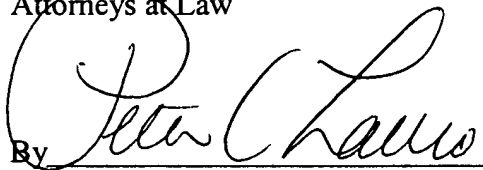
In addition, the instant application is a continuation of U.S. Serial No. 09/143,403, filed August 14, 1998 (the parent application), which in turn is a continuation of U.S. Serial No. 08/363,868, filed December 27, 1994 (the grandparent application). The Examiner's attention is invited to the fact that the instant application and the parent and grandparent applications were filed with identical claim sets. However, no restriction requirements were made in either the parent or grandparent applications. Apparently, the Examiner's assigned to these prior applications did not find distinct inventions or any burden in examining all the claims. Therefore, it appears inconsistent and unwarranted that a restriction requirement has issued in the instant application.

Therefore, in the interest of savings of time and cost to Applicants and the Patent Office, Applicants respectfully request that all the claims be searched and examined in a single application and that Groups I and II be rejoined into a single group.

Nevertheless, in compliance with the directives in the Office Action and in order to expedite prosecution of the instant application, Applicants hereby elect, subject to the foregoing traverse, Group I, claims 1-16, 24, 33-39, 41, 46, 48 and 49, drawn to recombinant host cells.

If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned attorney at (617) 227-7400.

LAHIVE & COCKFIELD, LLP
Attorneys at Law

By 

Peter C. Lauro, Esq.
Registration No. 32,360
Attorney for Applicants

28 State Street
Boston, MA 02109
(617) 227-7400
Facsimile (617) 742-4214

DATED: January 18, 2002